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10/560,140	09/20/2006	Sandro Wartack	56595/M521	9454

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EXAMINER

KELLER, MICHAEL J

ART UNIT

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3634

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/560,140

**Applicant(s)**

WARTZACK ET AL.

**Examiner**

Michael J. Keller

**Art Unit**

3634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 October 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-58 is/are pending in the application.  
4a) Of the above claim(s) 7, 8, 11, 12, 15, 17-19, 23, 24, 27-29, 52, 54, 57 and 58 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-6, 9, 10, 13, 14, 16, 20-22, 25, 26, 30-51, 53, 55 and 56 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 13 October 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-646)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/09/2005, 01/19/2006, 06/26/2006  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_



**DETAILED ACTION**

***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Election/Restrictions***

2. Applicant's election of Species V in the reply filed on 10/13/2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
3. Examiner disagrees with Applicant's assertion that claims 7, 11, 12, 15, 23, 24, 57 and 58 are readable on the elected species. Claims 7, 11 and 12 claim that the sealing member is movable by folding to expose the fixings. The sealing member of Species V (Fig. 12) is movable by sliding displacement not folding. Claims 15, 23, 24, 57 and 58 recite a fixing flange to which the sealing member is fixed. The sealing member of Species V is fixed to a fixing rail not a fixing flange.
4. Claims 1-6, 9, 10, 13, 14, 16, 20-22, 25, 26, 30-51, 53, 55 and 56 are readable on the elected species.
5. Claims 7, 8, 11, 12, 15, 17-19, 23, 24, 27-29, 52, 54, 57 and 58 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 3-5, 13-16, 25-29, 43, 44, and 51-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
8. Claim 3 recites the limitation "the uncovered state" in line 2. There is insufficient antecedent basis for this limitation in the claim. Furthermore it is unclear whether this refers to an uncovered state of the fixings or the vehicle door.
9. Claim 4 recites the limitation "the visible fixings" in 2. There is insufficient antecedent basis for this limitation in the claim.
10. Claim 5 recites the limitation "the closed state" in 2. There is insufficient antecedent basis for this limitation in the claim.
11. Claim 13 recites the limitation "the seal" in line 2. There is insufficient antecedent basis for this limitation in the claim.
12. Claim 25 recites "a door inside trim, where necessary including edge fascia panels." It is unclear whether edge fascia panels are included in the claim, because there is no standard set forth by Applicant for determining where edge fascia panels would or would not be necessary.
13. Claim 43 recites the limitation "their reinforcement areas" in line 2, apparently referring to reinforcement areas of the unit carrier and the outer module. There is insufficient antecedent basis for reinforcement areas of the outer module in the claim.

14. Claim 44 recites "the reinforcement areas of the unit carrier and the outer module" in lines 2-3. There is insufficient antecedent basis for reinforcement areas of the outer module in the claim.

15. Claim 51 recites the limitation "the fixing points" in 2. There is insufficient antecedent basis for this limitation in the claim.

16. Claim 53 recites the limitation "the uncovered state" in line 11. There is insufficient antecedent basis for this limitation in the claim. Furthermore it is unclear whether this refers to an uncovered state of the fixings or the vehicle door.

***Claim Rejections - 35 USC § 102***

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18. **Claims 1-6, 13, 14, 31-33, 39, 40, 42-45 and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaye (US 4,818,014).**

Regarding **claim 1**, Kaye discloses a motor vehicle door comprising: an outer module 26 (Fig. 3), a unit carrier 24, and a sealing member 44 covering a portion of an interface between the outer module and the unit carrier.

Regarding **claims 2-4**, Kaye discloses fixings 40 connecting the unit carrier to the outer module, wherein the fixings are covered by the sealing member.

Regarding **claim 5**, the sealing member forms a seal between the vehicle door 22 and the vehicle body 14.

Regarding **claim 6**, the sealing member could be removed to expose the fixings.

Regarding **claims 13 and 14**, Kaye discloses a fixing region (the region surrounding fixings 40) to which the sealing member is fixed in a push-fit connection (shown in Fig. 4 and 5).

Regarding **claims 31-33**, the outer module 26 has reinforcement areas 26b protruding inwards from the outer module, which run along the outer edges of the outer module.

Regarding **claims 39 and 40**, the unit carrier 24 has reinforcement areas 24b protruding outwards from the unit carrier, which run along the outer edges of the unit carrier.

Regarding **claim 42**, the unit carrier is made of metal (Col. 4 Line 45). While Kaye does not disclose stamping or deep drawing, Examiner notes that the method of forming a product is not germane to the patentability of the product itself. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted)

Regarding **claim 43**, see Fig. 3.

Regarding **claim 44**, fixing points 40 and 42 are provided on the reinforcement areas.

Regarding **claim 45**, the unit carrier and outer module are fixed against each other along an overlapping area which in cross-section is angled at least once (Fig. 10).

Regarding **claim 53**, Kaye discloses a motor vehicle door according claim 3 as set forth above.

**19. Claims 1, 5, 13, 14, 16, 20-22 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Morihara et al. (US 5,649,405).**

Regarding **claim 1**, Morihara discloses a motor vehicle door comprising: an outer module 21 (left side; Fig. 6), a unit carrier 21 (right side), and a sealing member 1c covering a portion of an interface between the outer module and the unit carrier.

Regarding **claim 5**, the sealing member forms a seal between the vehicle door 20 and the vehicle body 10.

Regarding **claims 13, 14 and 16**, Morihara discloses a fixing region 9 to which the sealing member is fixed in a push-fit connection, wherein the fixing region is a fixing rail.

Regarding **claims 20-22**, the method of forming a product is not germane to the patentability of the product itself, as noted above.

Regarding **claim 51**, the unit carrier has a double layered section as shown in Fig. 6.

**20. Claims 1-6, 13, 14, 20-22, 31-34, 39, 40, 42-44 and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Maass (US 2001/0033062).**



Regarding **claim 1**, Maass discloses a motor vehicle door comprising: an outer module 2b and 2c, a unit carrier 2a, and a sealing member 4 covering a portion of an interface between the outer module and the unit carrier.

Regarding **claims 2-4**, Maass discloses fixings 11 connecting the unit carrier to the outer module, wherein the fixings are covered by the sealing member.

Regarding **claim 5**, the sealing member forms a seal between the vehicle door 2 and the vehicle body 5.

Regarding **claim 6**, the sealing member could be removed to expose the fixings.

Regarding **claims 13 and 14**, Maass discloses a fixing region (the region surrounding fixings 11) to which the sealing member is fixed in a push-fit connection.

Regarding **claims 20-22**, the method of forming a product is not germane to the patentability of the product itself, as noted above.

Regarding **claims 31-34**, the outer module has reinforcement areas 2b protruding inwards from the outer module, which run along the outer edges of the outer module.

Regarding **claims 39 and 40**, the unit carrier 2a has reinforcement areas (horizontal portion of 2a) protruding outwards from the unit carrier, which run along the outer edges of the unit carrier.

Regarding **claim 42**, the unit carrier is made of metal (Paragraph 25). While Maass does not disclose stamping or deep drawing, Examiner notes that the method of forming a product is not germane to the patentability of the product itself.

Regarding **claim 43**, see Figure.

Regarding **claim 44**, fixing points (holes which fixings 11 pass through) are provided on the reinforcement areas.

Regarding **claim 53**, Maass discloses a motor vehicle door according claim 3 as set forth above.

***Claim Rejections - 35 USC § 103***

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. **Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maass (US 2001/0033062).**

Examiner takes Official Notice that it was previously known in the art to paint the exterior of a vehicle a different color than the unit carrier. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to paint the exterior of the outer module a different color than the unit carrier, in order to create an aesthetically pleasing appearance for the exterior of the vehicle.

23. **Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maass (US 2001/0033062) in view of Bright (US 4,858,385).**

Maass discloses a motor vehicle door according to claim 1, as set forth above, but does not disclose wherein a window frame is integrated in the unit carrier.

Bright discloses a motor vehicle door wherein a window frame is integrated in a unit carrier, as shown in Fig. 1.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to integrate a window frame in the unit carrier of Maass, in order to simplify manufacturing by reducing the number of parts to be assembled.

**24. Claims 25, 26 and 46-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maass (US 2001/0033062) in view of Fukumoto et al. (US 6,231,112).**

Regarding **claims 25 and 26**, Maass discloses a motor vehicle door according to claim 1, as set forth above, but does not disclose a door inside trim mounted on the unit carrier.

Fukumoto discloses a motor vehicle door comprising: a unit carrier 6 and a door inside trim 3 mounted on the unit carrier (Fig. 1).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to provide the motor vehicle door of Maass with the door inside trim of Fukumoto, in order to create an aesthetically pleasing for the interior of the vehicle.

Regarding **claims 46 and 47**, Maass discloses a motor vehicle door according to claim 1, as set forth above, but does not disclose a lock module.

Fukumoto discloses a motor vehicle door comprising: an outer module 2 and 52, a unit carrier 6 and a lock module 11 fixed on an overlapping area of the outer module and unit carrier (Fig. 9).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to provide the motor vehicle door of Maass with the lock module of Fukumoto, in order to allow the door to be held closed against the vehicle body.

Regarding **claims 48-50**, Maass discloses a motor vehicle door according to claim 1, as set forth above, but does not disclose a hinge part.

Fukumoto discloses a motor vehicle door comprising: an outer module 2 and 51, a unit carrier 6 and a hinge part 9 fixed to a hinge reinforcement 7 on an overlapping area of the outer module and unit carrier (Fig. 5).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to provide the motor vehicle door of Maas with the hinge part and hinge reinforcement of Fukumoto, in order to allow the door to swing relative to the vehicle body.

**25. Claims 1-6, 9, 10, 13, 14, 16, 20-22, 30-33, 35, 38-41, 43, 44, 53, 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imura et al. (US 4,651,470) in view of Thompson (US 4,916,864).**

Regarding **claims 1-4 and 53**, Imura discloses a motor vehicle door comprising: an outer module 2, a unit carrier 3, a sealing member 37 mounted on a fixing rail, and fixings 3d connecting the outer module to the unit carrier, but does not disclose wherein the fixings are covered by the sealing member.

Thompson discloses a door comprising: a first section 14, a second section 16, a sealing member 23 mounted on a fixing rail 22, and fixings 26 connecting the fixing rail and first and second sections.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to connect the rail of Imura to the unit carrier and outer module using the

fixings, as disclosed by Thompson. Doing so would eliminate the need for additional fastening means for connecting the fixing rail to the unit carrier.

Regarding **claim 5**, the sealing member forms a seal between the vehicle door and the vehicle body S.

Regarding **claim 6**, the sealing member could be removed to expose the fixings.

Regarding **claims 9 and 10**, the sealing member is slidable within the fixing rail.

Regarding **claims 13, 14 and 16**, the sealing member is attached to the fixing rail in a push-fit connection.

Regarding **claims 20-22, 55 and 56**, the method of forming a product is not germane to the patentability of the product itself, as noted above.

Regarding **claim 30**, Imura discloses a window glass driving mechanism (Col. 6 Lines 6-8).

Regarding **claims 31-33**, Imura discloses the outer module has reinforcement areas 11a protruding inwards from the outer module, which run along the outer edges of the outer module.

Regarding **claim 35**, Imura discloses a cross support 9 mounted on the outer module.

Regarding **claim 38**, see Imura Fig. 4.

Regarding **claims 39-41**, Imura discloses the unit carrier has reinforcement areas 3g protruding outwards from the unit carrier, which reinforcement areas run substantially U-shaped along the outer edges of the unit carrier.

Regarding **claim 43**, see Imura Fig. 6.

Regarding **claim 44**, Imura discloses fixing points (3f and holes in 11a) provided on the reinforcement areas.

***Conclusion***

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The documents cited on form PTO-892 disclose doors similar to that of Applicant's invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Keller whose telephone number is 571-270-5219. The examiner can normally be reached on Monday - Friday 9:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katherine Mitchell can be reached on 571-272-7069. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/560,140  
Art Unit: 3634

Page 13

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Primary Examiner, Art Unit 3634